

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-12 are now in the application. Claims 1 and 8 have been amended. Claims 10-12 were added. Support for claim 10-12 is found in original claims 1, 2-5, 6, and 7. No new matter has been added.

In item 2 on page 2 of the above-identified Office action, the Examiner stated that the IDS filed 3/15/2004 fails to comply with 37 CFR 1.98(a)(3).

The Examiner stated that DE 199 01 698 A1 does not include a concise explanation of the relevance. As stated in the IDS filed 3/15/2004, the patent to Greive et al. (U.S. Patent No. 6,176,484 B1) corresponds to DE 199 01 698 A1. The U.S. Patent can be considered as the statement of relevance. Accordingly, the IDS does comply with 37 CFR 1.98(a)(3). Therefore, no further action will be taken with respect to the IDS.

In item 3 on page 2 of the Office action the Examiner has objected to the disclosure because of the following informalities.

The headings should appear in upper case, without underlining, as a section heading (37 CFR 1.77(b)). The CFR states that the section heading should be in upper case without underlining, it does not state that the section heading must be in upper case without underlining. Accordingly, the headings are acceptable in their current form. Therefore, the specification has not been amended to overcome the objection by the Examiner.

In item 4 on page 2 of the Office action the drawings have been objected to under 37 CFR 1.84(p)(4).

The Examiner stated that the reference character "52" has been used to designate two different edges in Fig. 2. Figure 2 has been changed and one of the reference characters "52" has been removed. Therefore, the objection to the drawings by the Examiner is believed to have been overcome.

In item 4 on page 2 of the Office action the drawings have been objected to under 37 CFR 1.84(p)(5).

The Examiner stated that the reference symbol "53" used in the specification is not shown in the drawings. Figure 2 has been changed and the reference symbol "53" has been added.

Therefore, the objection to the drawings by the Examiner is believed to have been overcome.

In item 6 on page 3 of the Office action, claims 1-7 have been rejected as failing to comply with the enablement requirement under 35 U.S.C. § 112, first paragraph.

More specifically, the Examiner alleges that one of ordinary skill in the art would not be able to reproduce the invention claimed to adjust height in accordance with thickness from neither the specification nor the claims.

Applicants respectfully disagree with the Examiner's allegations. Figure 1 of the instant application shows the thickness of the sheet 1 to be "d". Furthermore, the specification discloses on page 4, line 21 to page 5, line 14 that it is possible to provide a central suction box in a vertically adjustable manner. It is disclosed that the height of the suction box is set according to the thickness "d" of the sheet to be transported. A person of skill in the art knows that the thicker the sheet is, the more clearance is required between the conveyor and the printhead. Without sufficient clearance between the print head and the conveyor a collision would occur between the sheet and the printhead. Moreover, page 8, line 18 to page 10, line 10 along with Figs.

Applic. No. 10/801,964
Amdt. dated October 11, 2005
Reply to Office action of July 11, 2005

3 and 4 further set forth how the height adjustment functions. Accordingly, the specification and claims are enabling. Therefore, neither the claims nor the specification has been amended to overcome the rejection.

It is accordingly believed that the specification and the claims meet the requirements of 35 U.S.C. § 112, first paragraph. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved.

In item 8 on page 4 of the Office action, claims 1, 2, 6, 7, 8, and 9 have been rejected as being obvious over Rasmussen et al. (U.S. Patent No. 5,992,994) in view of Doyle (U.S. Patent No. 6,032,577) (hereinafter "Rasmussen") under 35 U.S.C. § 103.

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. The claims are patentable for the reasons set forth below. Support for the changes is found on page 7, lines 7-12 of the specification.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 and 8 call for, *inter alia*:

a coupling between the guide element assigned to the central conveying segment and an adjacent guide element assigned to an adjacent conveying segment such that a height adjustment of the central guide element adjusts the height of the adjacent guide element.

The Rasmussen reference discloses a media support system. The system has a height adjustable support shoe (95) that can be moved toward or away from a printhead (54). A belt (62) is lead over the support shoe (95). The support system only has one conveyor belt section.

The Doyle reference discloses conveyor segments (34a-34c) for circuit boards. The conveyor segments work independently of one another (column 2, lines 20-26).

A circuit board is relatively rigid in comparison to a sheet of paper. Therefore, as shown in Fig. 6 of Doyle, it is possible for lifters (108) to lift the circuit board (122) off of the conveyor belts (103).

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

The references do not show or suggest a coupling between the guide element assigned to the central conveying segment and an adjacent guide element assigned to an adjacent conveying segment such that a height adjustment of the central guide element adjusts the height of the adjacent guide element, as recited in claims 1 and 8 of the instant application.

As correctly stated by the Examiner, the Rasmussen reference does not disclose three mutually adjacent conveying sections. Therefore, Rasmussen does not disclose a coupling between adjacent guide elements on adjacent conveying segments. This is contrary to the invention of the instant application as claimed, in which a coupling between the guide element assigned to the central conveying segment and an adjacent guide element assigned to an adjacent conveying segment such that a height adjustment of the central guide element adjusts the height of the adjacent guide element.

The Doyle reference discloses independent conveying segments. Doyle does not disclose a coupling between adjacent guide elements on adjacent conveying segments. This is contrary to

the invention of the instant application as claimed, in which a coupling between the guide element assigned to the central conveying segment and an adjacent guide element assigned to an adjacent conveying segment such that a height adjustment of the central guide element adjusts the height of the adjacent guide element.

The references applied by the Examiner do not teach or suggest all the claim limitations of amended claims. Therefore, it is believed that the Examiner's *prima facie* case of obviousness is not valid.

Claim 10 calls for, *inter alia*:

the central suction box being connected to the adjacent the suction boxes in an articulated manner, the adjacent suction boxes being pivotally mounted and articulated about respective pivot axes.

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

The references do not show or suggest the central suction box being connected to the adjacent the suction boxes in an

articulated manner, the adjacent suction boxes being pivotally mounted and articulated about respective pivot axes, as recited in claim 10 of the instant application.

As correctly stated by the Examiner, the Rasmussen reference does not disclose three mutually adjacent conveying sections. Therefore, Rasmussen does not disclose a central suction box being connected to the adjacent the suction boxes in an articulated manner. This is contrary to the invention of the instant application as claimed, in which the central suction box is connected to the adjacent the suction boxes in an articulated manner, the adjacent suction boxes are pivotally mounted and articulated about respective pivot axes.

The Doyle reference discloses independent conveying segments. Doyle does not disclose a central suction box being connected to the adjacent the suction boxes in an articulated manner. This is contrary to the invention of the instant application as claimed, in which the central suction box is connected to the adjacent the suction boxes in an articulated manner, the adjacent suction boxes are pivotally mounted and articulated about respective pivot axes.

The references applied by the Examiner do not teach or suggest all the claim limitations of amended claims. Therefore, it is

believed that the Examiner's *prima facie* case of obviousness is not valid.

In item 9 on page 5 of the Office action, claims 3, 4, and 5 have been rejected as being obvious over Rasmussen (U.S. Patent No. 5,992,994) in view of Doyle (U.S. Patent No. 6,032,577) and further in view of Scorl et al. (U.S. Patent No. 5,524,676) (hereinafter "Scorl") and Maass (U.S. Patent No. 5,697,606) under 35 U.S.C. § 103. Maass and Scorl do not make up for the deficiencies of Rasmussen and Doyle. Since claim 1 is allowable, dependent claims 3, 4, and 5 are allowable as well.

Even though the claims are believed to be allowable, the following remarks pertain to Maass and Scorl.

It is noted that the corporate assignee of the Maass reference is also the assignee of the instant application. Therefore, applicants are very familiar with the reference.

The Maass reference discloses a supply table of a sheet feeder. The supply table has three suction chambers (1, 2, 3) disposed under a conveying plane (5). None of the suction chambers (1, 2, 3) have a height that is adjustable because a sheet is always present on the conveying plane (5). In a

sheet feeder the sheet is only guided laterally. A height adjustment is not necessary because a sheet feeder does not have a printhead which requires a clearance with respect to the sheet. Therefore, the Maas reference does suggest a suction box with a height that is adjustable.

The Scorl reference discloses a weaving loom with plurality of pivotally interlinked suction boxes (18) that form a suction channel chain (17). Support rails (16) carry the suction channel chain (17), the support rails (16) fix the position of the suction boxes (18). A change in the position of the suction boxes in the sense of a height adjustment is not desired as this would cause the suction boxes (18) to be raised off of the support rails (16). Because a weaving loom does not disclose a belt for conveying sheets, Scorl does not suggest that the adjacent suction boxes are articulated about respective pivot axes coaxially aligned in each case with a rotational axis of a respective the deflection roller of the conveyer belt, as recited in claim 5 of the instant application.

Furthermore, it is noted that new claim 10 includes the subject matter of claims 1, 3, 4, and 5. Therefore, claim 10 will be discussed with respect to the rejection over Rasmussen in view of Doyle and further in view of Scorl and Maas.

Claim 10 calls for, *inter alia*:

an apparatus for adjusting a height of a central suction box in a direction of the print head and the guide element assigned to the central conveying segment opposite the print head ... and the adjacent suction boxes being pivotally mounted and articulated about respective pivot axes coaxially aligned in each case with a rotational axis of a respective deflection roller.

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

The references do not show or suggest an apparatus for adjusting a height of a central suction box in a direction of the print head and the guide element assigned to the central conveying segment opposite the print head ... and the adjacent suction boxes being pivotally mounted and articulated about respective pivot axes coaxially aligned in each case with a rotational axis of a respective deflection roller, as recited in claim 10 of the instant application.

The Maas reference discloses a supply table that has three suction chambers disposed under a conveying plane. None of the suction chambers have a height that is adjustable. A height adjustment is not necessary because a sheet feeder does not have a printhead, which requires a clearance with respect to the sheet. Therefore, the Maas reference does suggest a suction box with a height that is adjustable. This is contrary to the invention of the instant application as claimed, in which an apparatus adjusts a height of a central suction box in a direction of the print head and the guide element assigned to the central conveying segment opposite the print head in accordance with a thickness of the sheets.

The Scorl reference discloses a weaving loom with plurality of pivotally interlinked suction boxes (18) that form a suction channel chain (17). A change in the position of the suction boxes in the sense of a height adjustment is not desired as this would cause the suction boxes (18) to be raised off of the support rails (16). Because a weaving loom does not disclose a belt for conveying sheets, Scorl does not suggest that the adjacent suction boxes are articulated about respective pivot axes coaxially aligned in each case with a rotational axis of a respective deflection roller of the conveyer belt. This is contrary to the invention of the instant application as claimed, in which an apparatus adjusts a

height of a central suction box in a direction of the print head and the guide element assigned to the central conveying segment opposite the print head ... and the adjacent suction boxes are pivotally mounted and articulated about respective pivot axes coaxially aligned in each case with a rotational axis of a respective deflection roller.

The references applied by the Examiner do not teach or suggest all the claim limitations of amended claims. Therefore, it is believed that the Examiner's *prima facie* case of obviousness is not valid.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting

Applic. No. 10/801,964
Amdt. dated October 11, 2005
Reply to Office action of July 11, 2005

W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540,
1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125,1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS

Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments, it is respectfully believed that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, claim 10 is believed to be allowable.

In item 9 on page 7 of the Office action, claim 7 has been rejected as being obvious over Rasmussen (U.S. Patent No. 5,992,994) in view of Doyle (U.S. Patent No. 6,032,577) and

Applic. No. 10/801,964
Amdt. dated October 11, 2005
Reply to Office action of July 11, 2005

further in view of Hayashi et al. (U.S. Patent No. 6,547,384 B2) (hereinafter "Hayashi") under 35 U.S.C. § 103. Hayashi does not make up for the deficiencies of Rasmussen and Doyle. Since claim 1 is allowable, dependent claim 7 is allowable as well.

Even though the claims are believed to be allowable, the following remarks pertain to Hayashi.

The Examiner alleges that the Hayashi reference discloses rollers (61 and 62) for the purpose of facilitating the vertical guiding of the guide element. The description of Figs. 5 and 6 pertains to a drive for the sprockets (61 and 62) for the horizontal feed of the recording medium (8). The vertical adjustment with respect to the printhead (3) is made with a rack (16) which engages a pinion (17) of a motor (18). This does not obviate claim 7 of the instant application.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1, 8, or 10. Claims 1, 8, and 10 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claims 1, 8, or 10 they are believed to be patentable as well.

Applic. No. 10/801,964
Amdt. dated October 11, 2005
Reply to Office action of July 11, 2005

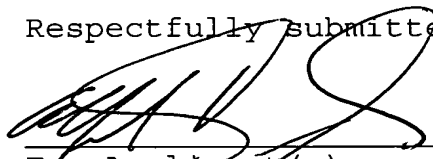
In view of the foregoing, reconsideration and allowance of claims 1-12 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner & Greenberg P.A., No. 12-1099.

Respectfully submitted,



For Applicant(s)

Alfred K. Dassler
52,794

AKD:cgm

October 11, 2005

Lerner and Greenberg, P.A.
Post Office Box 2480
Hollywood, FL 33022-2480
Tel: (954) 925-1100
Fax: (954) 925-1101

Applic. No. 10/801,964
Amdt. dated October 11, 2005
Reply to Office action of July 11, 2005

Drawing Amendments

The attached sheet of drawings includes changes to Fig. 2.

This sheet which includes Fig. 2, replaces the original sheet including Fig. 2. In Fig. 2, previously omitted element "53" was were added. The extra element "52" was deleted.

Please approve the drawing changes that are marked in red on the accompanying "Annotated Sheet Showing Changes" of Fig. 2. A formal "Replacement Sheet" of amended Fig. 2 is also enclosed.

Attachments: Replacement Sheet
Annotated Sheet Showing Changes



FIG. 2
~~FIG. 2~~

